

## REMARKS

### I. Introduction

Claims 1-71 are pending in this application.

Claims 1-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable by Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue").

Applicants have amended claims 1, 20, 21, 22, 32, 35, 36, 37, 40 and 41. No new subject matter has been added and the amendments are fully supported and justified by the specification.

The Examiner's rejection is respectfully traversed.

### II. Applicants' Reply To The Rejection Of The Claims

All of the rejections set forth in the June 17, 2003 Final Office Action are under 35 U.S.C. § 103(a) and are based on combining Brenner with LaDue.

The Examiner maintains the rejection of claims 1-71 because he believes that there is sufficient motivation to combine the wireless gaming caddy disclosed by LaDue with the off-track wagering system taught by Brenner in order to provide the user with a portable, wireless two-way data communications gaming or wagering system (Office Action, page 2). Applicants respectfully disagree with the Examiner's conclusion that there is sufficient motivation to combine Brenner with LaDue.

However, in the interest of advancing prosecution of this case, applicants have amended independent claims 1, 32, 35, 36, 37, 40 and 41 and have set forth reasons as to why the amended claims are allowable.

Applicants' independent claims 1, 32, 35, 36, 37, 40 and 41 are directed towards methods, systems and machine-readable media for interactive wagering on races with a cellular telephone. For example, as defined by amended independent claims 1 and 41, racing data on races that have not been run and for which wagers may be placed are received at the cellular telephone. A user is allowed to select to present the racing data in audio form or visual form. The racing data on the races that have not been run and for which wagers may be placed are presented on the cellular telephone based on the user selection. Interactive options are provided on the cellular telephone that allow the user using the cellular telephone to place a wager on a given race that has not been run.

Applicants respectfully submit that the rejections based on combining Brenner with LaDue should be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness. Claims 1-71 are allowable over Brenner in view of LaDue for at least the following reasons.

A.    The Combination of Brenner with LaDue Does Not  
Show Or Suggest All Elements of Applicants' Claims

Generally speaking, Brenner refers to systems and methods for interactive off-track wagering. Brenner, however, as admitted by the Examiner, "does not expressly disclose the method for interactive wagering utilizing a cellular telephone that is in a wireless data communications network" (Office Action, page 5). Nevertheless, the Examiner contends that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the conventional wireline data communications network system of Brenner with the wireless cellular radio system, as taught by LaDue, for the purpose of providing the user with a portable, wireless two way data communications gaming or wagering system" (Office Action, pages 5-6). In particular, LaDue provides "a cellular telephone" (Office Action, page 5).

Applicants respectfully disagree with the Examiner's conclusion, but in the interest of advancing prosecution of this case, applicants have amended independent claims 1, 32, 35, 36, 37, 40 and 41. Applicants submit that the amended claims patentably improve upon Brenner at least in that it "allow[s] the user to select to present the racing data in audio form or visual form" and "present[s] the racing data on the races that have not been run and for which wagers may be placed on the cellular telephone based on the user selection."

Applicants further submit that LaDue merely shows that gaming odds may be transmitted to the gaming caddy for display on an LCD display (see column 11, lines 2-9). Nowhere in LaDue is it shown or suggested that a user is allowed to select whether to present racing data on the cellular telephone in audio form or visual form, as specified by applicants' claims. As a result, applicants also submits that LaDue does not present the racing data on the cellular telephone based on the user selection, as specified by applicants' claims.

Therefore, for at least the foregoing reasons, applicants respectfully request that the rejection of claims 1-71 under 35 U.S.C. § 103(a) be withdrawn.

B. "Providing The User With A Portable, Wireless Wagering System" Is Not A Sufficient Motivation

Even if the combination of Brenner with LaDue shows or suggests every element of independent claims 1, 32, 35, 36, 37, 40 and 41, which it does not, the Examiner fails to provide a sufficient motivation for combining the references. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01.

Instead of providing the requisite teaching or motivation for combining the references, the Examiner merely

concludes that it would have been obvious to combine Brenner with LaDue "for the purpose of providing the user with a portable, wireless two way data communications gaming or wagering system." But such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also MPEP § 2143.

Without a proper motivation for combining the references, the Examiner has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. In re Dembiczak, 175 F.3d 994, 999.

C. "Inviting The Applicants' Attention To The Proliferation Of Wireless Technology" Is Also Not A Sufficient Motivation

The Examiner also invites the applicants' attention to the proliferation of wireless technology in every part of our daily applications" (Office Action, page 2). Applicants respectfully submit that this is also not a sufficient motivation to provide the wagering interfaces of Brenner on the CCAD gaming communicator of LaDue for at least the following reason.

With respect to what is well known to a person of ordinary skill in the art, the Examiner has failed to point to

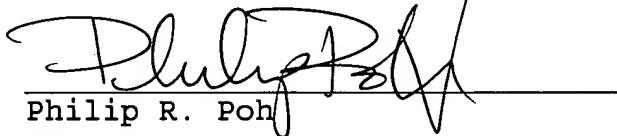
any particular reference related to "allowing a user at the cellular telephone to access an interactive wagering service over a wireless communications path to obtain information on races that have not been run and for which wagers may be placed, wherein the cellular telephone is configured to place and receive voice telephone calls over the wireless communications path" and "allow[ing] the user to place a wager on a given race that has not been run using the cellular telephone." It is applicants' understanding that such features are not well known in the art.

Further, the Examiner's reliance on the proliferation of wireless technology in every part of our daily applications does not overcome the fact that the combination of Brenner with the CCAD gaming communicator of LaDue would not result in the inclusion of wagering interfaces of Brenner on a cellular telephone (Office Action, page 2).

III. Conclusion

For the reasons set forth above, claims 1-71 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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